

REMARKS

Claims 19 and 20 are canceled without prejudice, claim 40 is added, and therefore claims 17, 18 and 21 to 40 are now pending.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

In response to the request for a copy of the previously disclosed reference, while it believed that copies should already have been provided by the International Searching Authority, another courtesy copy accompanies this response. It is respectfully requested that all references be considered and made of record.

Claims 17 and 24 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 6,561,295 to Kuroda et al., (“Kuroda”).

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 17 has been rewritten to include the feature of “*lowering a setpoint value of the state of charge by a value that corresponds to a likely charge to be received by the energy accumulator during a deceleration of the vehicle from an instantaneous velocity to a standstill, wherein the value that corresponds to a*

likely charge to be received is obtained by accessing a predefined characteristic curve that predicts the value that corresponds to a likely charge to be received as a function of velocity.”

The Kuroda reference does not identically disclose (or even suggest) the feature of lowering a setpoint value by a value “obtained by accessing a predefined characteristic curve that predicts the value that corresponds to a likely charge to be received as a function of velocity”, as provided for in the context of the presently claimed subject matter. In fact, Kuroda does not appear to use any characteristic curve whatsoever to control a setpoint value correspond to state of charge, as provided for in the context of the presently claimed subject matter.

Claim 24, as presented, include features analogous to those of claim 17, as presented, and it is therefore allowable for essentially the same reasons as claim 17, as presented.

Claims 17 to 20, 24, 25 and 27 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 6,344,732 to Suzuki.

It is believed and respectfully submitted that Suzuki does not identically disclose (or even suggest) the feature of lowering a setpoint value by a value “obtained by accessing a predefined characteristic curve that predicts the value that corresponds to a likely charge to be received as a function of velocity”, as provided for in the context of the presently claimed subject matter.

As indicated in Fig. 5 and col. 6, line 48 to col. 7, line 26, the setpoint value is set to a default value of 60% and thereafter increased to 70% or decreased to 50% depending on the velocity. This changing of the setpoint value does not take into account the predicted amount of charge that is likely to be received. Instead, it is apparent that the Suzuki reference merely concerns predicting a general trend in the amount of regenerative energy and making coarse adjustments to the setpoint value in response to that trend.

Accordingly, claims 17 and 24 as well as dependent claims 18, 25 and 27 are allowable over the Suzuki reference.

Claims 17 to 21, 24, 25 and 27 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 5,469,816 to Murakawa et al., (“Murakawa”).

The Murakawa reference does not identically disclose (or even suggest) lowering a setpoint value by a value “obtained by accessing a predefined characteristic curve that predicts the value that corresponds to a likely charge to be received as a function of velocity.” Figure 18 of Murakawa refers to an internal map in which a target storage capacity is shown in relation to

vehicle speed. However, Murakawa provides no additional disclosure as to how the map is generated.

Therefore, it cannot be properly asserted that the target storage capacity is adjusted in accordance with a predicted value “that corresponds to a likely charge to be received as a function of velocity.” Even if Murakawa did indicate that there is some correlation between the target storage capacity and velocity, it discloses nothing as to how the correlation is derived or what the correlation indicates.

Accordingly, claims 17 and 24 as well as dependent claims 18, 21, 25 and 27 are allowable over the Murakawa reference.

Claims 22, 23, 29 to 33 and 35 to 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murakawa.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 22, 23 and 29 to 33 depend from claim 17, and claims 35 to 39 depend from claim 24. Accordingly, claims 22, 23, 29 to 33 and 35 to 39 are allowable for the same reasons as their respective base claims 17 and 24.

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Additionally, as to claims 33 and 39, the Office Action cites U.S. Patent Nos. 6,476,571 ("Sasaki") and 6,466,024 ("Rogers").

These references do not disclose the feature of providing additional energy when needed on a cold start, then later increasing charging capacity. The Sasaki reference only refers to extending a charging preset period, and the Rogers reference only refers to preheating a catalytic converter. Neither of these references teaches or suggests that a setpoint value "remains constant up to a predefined minimum velocity and drops subsequently to a maximum velocity with increasing slope above a state of charge limit", as provided for in the context of the presently claimed subject matter. Accordingly, claims 33 and 39 are allowable for these additional reasons.

Claims 26, 28 and 34 were rejected as being unpatentable over Murakawa in view of U.S. Patent Pub. No. 2004/0232861 to Wakashiro et al. ("Wakashiro") or U.S. Patent Pub. No. 2003/0076109 to Verbrugge et al. ("Verbrugge").

Claim 28 depends from claim 17 and claims 26 and 34 depend from claim 24, and they are allowable for at least the same reasons as base claims 17 and 24, since the Wakashiro and Verbrugge references do not cure – and have not been asserted to cure – the critical deficiencies of Murakawa with respect to claims 17 and 24.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) *or otherwise*. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

New claim 40 does not add new matter and is supported by the application, including the Specification, as originally filed. Claim 40 includes features like those of claims 17 and 24 and it is therefore allowable for essentially the same reasons and for the further reasons that it includes features that are not disclosed or suggested by the applied references, as any review of the applied references makes plain.

In view of the foregoing, claims 17, 18 and 21 to 40 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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